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entire reference as showing that part. 37 CFR § 1.104(c)(2)
states:

. . . the Examiner must cite the best
references at his . . . command.

**When a reference is complex or shows or
describes inventions other than that claimed
by the applicant, the particular part relied
on must be designated as nearly as
practicable.**

The pertinence of each reference, if not
apparent, must be clearly explained and each
rejected claim specified.

The Office Action fails to comply with this regulation.

Point 2

All rejections are obviousness-type. MPEP § 2143.03 states:

To establish prima facie obviousness . . . **all
the claim limitations** must be taught or
suggested by the prior art.

The Office Action fails to comply with this MPEP section. Citing
an **entire reference**, without greater specificity, fails to show
claim elements.

Point 3

Applicant first presents an analogy.

Assume a patent application on an automobile. Assume that the

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Inventor therein invented

- 1) a fantastic carburetor for the engine,
which gets 1,000 miles per gallon
and
- 2) fantastic tires which never wear out.

Even if the PTO shows that

- 1) the carburetor-plus-car is obvious
and
- 2) the tires-plus-car is obvious,

that does not show that tires-plus-carburetor-plus-car is obvious. One reason is that, under section 103, the "subject matter sought to be patented" "as a whole" must be shown as obvious. That has not been done.

In Applicant's case, every rejection follows the same pattern, which will be explained using a test claim containing recitations 1 through 4.

-- The Office Action combines references C and L to show recitation 1, and gives a reason X.

-- The Office Action combines references C and A to show recitation 3, and gives a **different** reason Y.

But that process fails to show that the claim is obvious. At best, that process shows (1) recitation 1 is obvious and (2)

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recitation 3 is obvious.

But that process has not shown that recitation 1 **PLUS** recitation 3 is obvious.

Point 4

The Office Action relies on inconsistent rationales for combining the references. Reason X in Point 3, above, is different from Reason Y.

This is significant because Reason X is not attained by the combination of references which is justified by Reason Y. Conversely, Reason Y is not attained by the combination of references which is justified by Reason X.

It would therefore appear that hindsight is being used. That is, reasons are being conjured for specific purposes, namely, to justify combining references. But the reasons are inconsistent.

Point 5

The Office Action is reasoning backward. The Office Action combines two references, and then justifies the combination by a verbatim quote taken from each. The justification, in effect, states that the combination produces a system having the characteristics in the quotes.

However, that is backward reasoning. A teaching for combining the references **in the first place** is required. If you look at each

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quote, the quotes do not suggest combining references.

The mere fact that a combination of references may be consistent with a quote in a reference is not a teaching for combining the references.

Also, at best (for the PTO) the references, when combined, supposedly possess characteristics described in the quotes. That is not a teaching for making the combination. One reason is that the reference containing the quote **by itself** provides the characteristic described in the quote.

Comment

Not all points made in this Summary are elaborated below. Many are considered self-explanatory.

END SUMMARY

RESPONSE TO REJECTIONS OF CLAIMS 15 - 17, 20, and 27

The claims identified in the heading above were rejected under section 103, based on Cheng, Lazarus, and Ackermann. Claim 15 recites:

15. A method, comprising:
 - a) identifying a target group of persons;
 - b) identifying attributes of persons in the target group,

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- c) representing attributes in consumer vectors, one vector per person, thereby producing a plurality of consumer vectors; and
- d) selecting at least some of the consumer vectors and, for each, generating an animated anthropomorphic idol which displays the attributes of the selected consumer vector.

Point 1

The Office Action fails to comply with 37 CFR § 1.104(c)(2), which states:

. . . the Examiner must cite the best references at his . . . command.

When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable.

The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

The Office Action cites Cheng, in its entirety, to show parts of claim 15(c) and (d). The Cheng reference is more than 35 columns in length. It is clearly "complex." Cheng clearly also shows "inventions other than that claimed." Thus, this regulation requires that **"the particular part relied on must be designated as nearly as practicable."**

That designation has not been done. Citing a reference in its entirety does not qualify as the required "designation."

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This applies to the Lazarus reference.

Point 2

No valid teaching has been given for combining the references, for several reasons.

Reason 1

The Office Action, bottom of page 6, proposes **two reasons** for combining the references. However, the law requires "a teaching," which is **singular**. MPEP § 2145(j)(3) states:

As discussed in MPEP § 2143.01, there must be **some suggestion** or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings.

The presence of two reasons creates problems. Is the PTO stating that each reason, independently, is sufficient to justify combining the references ? Or that both together are required ?

In the latter case, then proof that one of the reasons is invalid would be sufficient to defeat the teachings.

Reason 2

One of the reasons used by the PTO is a direct quote from Cheng. The other reason is a direct quote from Ackermann.

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The quote from Cheng (column 3, lines 14 - 20) is a definition of the term "virtual environment systems." The quote from Ackermann (column 2, lines 7 - 9) is part of a sentence which states one result which his invention accomplishes:

The invention may be implemented as a playful learning environment in which children experiment with dynamic systems by constructing and **transforming virtual objects through dialogic interaction with a computational device.**

(Ackermann, column 2, lines 5 - 9. Part quoted in Office Action is highlighted.)

As a self-evident general proposition, a definition given by a reference is not a teaching to combine that reference with another reference.

As a self-evident general proposition, a statement by a reference of a result which the reference accomplishes is not a teaching to combine that reference with another reference.

Exceptions could exist to these general propositions, but the PTO has shown no such exceptions.

Reason 3

As stated in Reason 2, the Office Action justifies combining the references using a quotation from Cheng. That quotation defines "virtual environment systems."

Thus, the justification merely states that, if the references

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are combined, then a "virtual environment system" is obtained. That is not a teaching for combining the references.

That merely asserts that a particular characteristic is obtained if the references are combined. The presence of characteristics in a combination of references is not a motivation to combine them.

Reason 4

The quotation from Ackermann sets forth a result which Ackermann's system supposedly accomplishes. That does not lead to a combination with Cheng. Ackermann, **by himself**, accomplishes the result.

If a reference sets forth a result, and asserts that it attains the result, there is no reason to look to other references to attain that result.

Reason 5

The Office Action is reasoning backward. The Office Action asserts that, if the references are combined, then the results in the two quotations are attained. That is not a teaching under section 103.

A teaching is required for combining the references **in the first place**. This will be proven by looking at the quotations.

The quotation from Cheng, included in its context, is this:

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Virtual environment system . . . refers to any . . . computing-based system capable of supporting a virtual world or other virtual environment, or settings/scenes thereof, particularly any such environment characterized by avatars, bots and other virtual objects.

(Cheng, column 3, lines 14 - 19. Highlighted part is used by Office Action as reason for combining references.)

As a matter of logic, that quotation does not suggest combining the reference with Ackermann, or making any modification of Cheng.

The same conclusion applies to the quotation from Ackermann.

Thus, if one looks at the quotations used by the Office Action, one is not motivated to combine the references containing the quotations with each other.

Point 3

Section 103 states that, for the rejection to stand, the "the subject matter sought to be patented" "as a whole" must be obvious. The Office Action has not met the "as a whole" requirement.

The Office Action combines Cheng with Lazarus to show part of claim 15, and combines Cheng with Ackermann to show another part. That does not show claim 15 "as a whole" to be obvious. The reasons are simple.

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Reason 1

As a matter of logic, the PTO is making one, or both, of the following combinations:

(Cheng plus Lazarus) with Ackermann

or

(Cheng plus Ackermann) with Lazarus.

But the PTO has provided no teaching for combining a pair of references with a third reference.

Reason 2

Stated another way, the PTO asserts that

(Cheng plus Lazarus) is obvious

and

(Cheng plus Ackermann) is obvious.

But, under the PTO's reasoning, all three references are required. The PTO must show that

(Cheng plus Lazarus) plus (Cheng plus
Ackermann) is obvious.

That has not been done.

General Reason

As a general matter, relying on a pair of references to show element A of a claim, and another pair of references to show element B does not show that the claim "as a whole" is obvious.

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Point 4

The rationales used by the Office Action are inconsistent. Cheng is combined with Lazarus on the grounds that the combination provides a "system for analyzing . . . financial behavior." However, the combination of Cheng with Ackermann does not provide such a system.

Again, the "as a whole" requirement is not met. A first justification is given for combining Cheng with Lazarus, and a second justification is given for combining Cheng with Ackermann.

But the second justification does not support the combination of Cheng with Lazarus, and the first justification does not support the combination of Cheng with Ackermann.

CLAIM 20

Claim 20(d) recites "measuring marketing success of each idol." The Office Action, page 10, asserts that Lazarus shows this.

However, in rejecting previous claims, the PTO relies on either Cheng or Ackermann to show an "idol" or "anthropomorphic idol." At no location does the PTO assert that Lazarus shows an "idol."

Applicant therefore requests, under 37 CFR §§ 1.104(c)(2) and 35 U.S.C. § 132, that the PTO specifically identify claim 20(d) in

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Lazarus. A reference to "whole document" is not sufficient.

CLAIM 27

Claim 27 recites:

27. A method, comprising:

- a) identifying a target group of consumers;
- b) for individuals in the group, identifying attributes of each and representing the attributes as consumer vectors, thereby producing one vector per individual;
- c) for selected consumer vectors, generating an animated anthropomorphic idol for each, the idol having an associated idol vector describing the idol's attributes, thereby producing a group of idols, each having an idol vector;
- d) presenting idols on web sites, together with merchandise available for sale, and taking orders for the merchandise from consumers, including consumers in the target group;
- e) generating a mapping of information which indicates, for each consumer vector, which idol vectors resulted in successful sales;
- f) ascertaining a mapping of the vectors which indicates which idols should be used for marketing activities to a sub-group of consumers, having consumer vectors identical to vectors selected from the target group.

Applicant points to claim 27(d), which recites:

- d) presenting idols on web sites, together with merchandise available

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for sale, and taking orders for the merchandise from consumers, including consumers in the target group.

("Idols" are animated figures acting a spokespersons, as it were.)

This recitation has not been shown in any reference.

Also, claim 27 recites, in part:

. . . .

d) presenting idols on web sites, together with merchandise available for sale, and taking orders for the merchandise from consumers, including consumers in the target group;

e) generating a mapping of information which indicates, for each consumer vector, which idol vectors resulted in successful sales;

f) ascertaining a mapping of the vectors which indicates which idols should be used for marketing activities to a sub-group of consumers, having consumer vectors identical to vectors selected from the target group.

These claim recitations have not been identified in the applied references. MPEP § 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

The wholesale citation of both Cheng and Lazarus to show these claim elements is insufficient.

Further, the Office Action, page 14, combines the "vectors"

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of Lazarus with Cheng. However, Lazarus shows a system of analyzing customer purchases, for marketing purposes. Cheng does not sell anything. There is no reason to combined these references.

RESPONSE TO SECTION 101-REJECTIONS

Claims 15 and 20

The grounds of rejection are that the claims "are not limited . . . to a useful, concrete, and tangible application."

Applicant requests a citation of authority in support of this contention. The MPEP section cited by the Office Action does not use this language. The Office Action cites five court decisions. However, under the principles of stare decisis, the court decisions are only relevant if the factual situations therein are the same as in the present application. Presumably, if they were, a rejection under section 103, based on the court decision(s), would have been made. Since that has not been done, it is clear that the facts in those decisions are different from those in the present application.

Authority for the grounds of rejection are requested, because the grounds appear to be invalid.

For example, the undersigned attorney has never seen a court decision stating that claims must be "limited to" a "useful" "application." This principle appears to be invalid on its face.

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"Claims" do not have "uses." Claims are words which define inventions.

If this principle is stating that the **claimed subject matter** must be "limited to" a "useful" "application," authority is further requested in support of that principle. A claim (which is a collection of words) cannot determine how the claimed subject matter is used.

Further, the statutory requirement that an invention be "useful" is not reflected in this principle. "Useful" means "having a use." The subject matter of claim 15 has a "use," in that the method described can be used to advertise a product.

The principle invoked by the Office Action, in effect, states the following:

-- claims must be "limited to" a "useful"
"application,"

AND

-- claims must be "limited to" a "concrete"
"application,"

AND

-- claims must be "limited to" a "tangible"
"application."

Applicant requests a citation of authority in support of the grounds of rejection. Applicant requests a definition of "useful," "concrete," "tangible," and "application."

Applicant further requests an answer to the following

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question. How can this principle be valid, in view of the following self-evident refutation of it ?

Refutation

Assume that the definitions requested above are supplied, and that a given claim satisfies the definition. But assume, in addition, that the given claim represents a device which accomplishes a task, such as drilling steel, much faster and cheaper than before. Such a claim is **NOT** "limited to" being "useful, concrete, and tangible." It is, in addition, "economical." Plainly, the generation of a valuable property by a claim does not render it unpatentable under section 101.

Thus, it cannot be correct to state that claims must be "limited . . . to a useful, concrete, and tangible application." Claims may have other properties.

This applies to the other claims rejected under section 101.

Additional Point

MPEP § 2106(c)(iii) states:

A series of specific operational steps to be performed on or with the aid of a computer is a statutory process.

The processes of all claims can clearly be "performed on or with the aid of a computer."

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Further, claims 16 - 19 recite "web sites." "Web sites" do not exist outside computers.

Further still, all other claims recite an "animated anthropomorphic idol." The undersigned attorney is unaware of how such an idol can be generated without computer assistance.

The undersigned attorney offers to consult the Assignee of the application, to consider adding language to the claims which recites involvement of a computer, in order to qualify under the MPEP section just quoted, if the PTO requests.

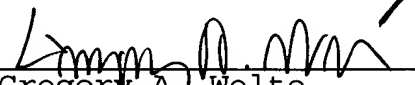
CONCLUSION

The preceding discussion applies to all claims.

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,


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